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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/740,505

12/19/2000

Karl E. Kurz

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4830

7590

09/23/2004

John E. Beck  
Xerox Corporation  
Xerox Square 20A  
Rochester, NY 14644

EXAMINER

MILIA, MARK R

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/740,505	<b>Applicant(s)</b> KURZ ET AL.	
	<b>Examiner</b> Mark R. Milia	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 0200 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/19/00 + 8/20/02</u> | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10-15, 18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6113208 to Benjamin et al.

Regarding claim 10, Benjamin discloses a method comprising: providing a printing machine (column 2 lines 54-55), installing a replaceable unit in the printing machine, the replaceable unit comprising: (a) a container for containing a marking substance used in a printing process in the printing machine, the container having a first volume of substance prior to use in the printing machine and a second volume of substance less than the first volume after use, and (b) a memory storage device functionally associated with the container, the memory storage device including data about the customer replaceable unit (see column 2 line 64-column 3 line 6, reference states the use of replaceable ink cartridges which inherently contain more fluid before use than after being used therefore the claim element is anticipated by the reference), transferring the data in the memory storage device to the printing machine (see column 3 lines 7-49), and upon reaching a threshold volume of substance in the container,

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printing a human readable document, the human readable document indicating: (a) at least one of a present and future need for a replacement replaceable unit; (b) replaceable unit model information, and (c) replaceable unit order information (see column 4 lines 20-40).

Regarding claim 11, Benjamin discloses a method comprising: providing a printing machine, the printing machine including a customer replaceable unit comprising a memory storage device, the memory storage device including data about the customer replaceable unit (see column 3 lines 1-7), communicating the data in the customer replaceable unit with the printing machine (see column 3 lines 7-49), and printing a human readable document including the data about the customer replaceable unit after a condition occurs in the customer replaceable unit (see column 4 lines 20-40).

Regarding claim 12, Benjamin discloses the method discussed above in claim 11, and further discloses wherein the data comprises information for at least one of ordering, returning, using, and installing the customer replaceable unit and wherein the document comprises information for at least one of ordering, returning, using, and installing the customer replaceable unit (see column 4 lines 20-40).

Regarding claim 13, Benjamin discloses a method for ordering a component for a printing apparatus comprising providing a replaceable unit including a memory containing data about the replaceable unit (see column 3 lines 1-6), providing a printing apparatus (see column 3 line 7 and Fig. 1), and printing a document including at least a portion of the data, the data relating to at least one of ordering, returning, using, and

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installing a replacement replaceable unit (see column 4 lines 35-39 and 42-45 and column 4 lines 20-40).

Regarding claim 14, Benjamin discloses the method discussed above in claim 13, and further discloses wherein the replaceable unit includes a first volume of a substance prior to use and a second volume of the substance less than the first volume after an increase in use (see column 2 line 64-column 3 line 6 and column 4 lines 20-40, reference states the use of replaceable ink cartridges which inherently contain more fluid before use than after being used therefore the claim element is anticipated by the reference).

Regarding claim 15, Benjamin discloses the method discussed above in claim 13, and further discloses printing a document containing information about a future disablement of the printing apparatus (see column 3 lines 42-45 and column 4 lines 20-40, reference states a message indicating the need for a replacement ink cartridge is output when a low ink level is determined which is analogous to the claimed element).

Regarding claim 18, Benjamin discloses the method discussed above in claim 13, and further discloses printing at least one of: (a) a URL address for electronic ordering of a replaceable unit; and (b) a URL address for obtaining instructions on obtaining a replacement replaceable unit (see column 3 line 50-column 4 line 11 and column 4 lines 20-50, reference shows an example in which automatic access and display of an internet website is acquired when there is a need to order a replacement cartridge which serves the same purpose as printing a document containing a URL to

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order a replacement cartridge therefore the claimed element is anticipated by the reference).

Regarding claim 20, Benjamin discloses the method discussed above in claim 13, and further discloses printing at least one of: (a) warranty information for the replaceable unit, (b) notification of the replaceable unit being used beyond its warranted life, (c) date of manufacture of the replaceable unit, (d) place of manufacture of the replaceable unit, and (e) a replacement instruction for the replaceable unit (see column 4 lines 20-40, reference states that upon a low ink level a blank order form is printed out containing the reorder part number which is equivalent to replacement instructions and is therefore anticipated by the reference).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin in view of U.S. Patent No. 6181885 to Best et al.

Regarding claim 1, Benjamin discloses a method for providing information to a user comprising: providing a printing machine (see Fig. 1 and column 2 lines 54-55), installing a replaceable component in the printing machine, the replaceable component including a memory storage device, the memory storage device containing data about the replaceable component (see column 3 lines 1-6 and 35-45 and column 4 lines 20-

40), electronically transferring data about the replaceable component to the printing machine (see column 3 lines 7-49), and printing a document including data about the replaceable component (see column 4 lines 20-40).

Benjamin does not disclose expressly the memory storage device containing data including an identification code of the replaceable component, electronically transferring the identification code of the replaceable component to the printing machine, and printing a document including at least the identification code of the replaceable component.

Best discloses replaceable components provided with memory storage having identification units, the component being able to display data about the replaceable component (see column 2 lines 7-45, column 6 lines 59-65, and column 7 lines 30-64).

Regarding claim 2, Benjamin discloses wherein the memory storage device further comprises a contact for ordering a replacement replaceable component and printing a document including a contact for ordering a replacement replaceable component upon a condition in the replaceable component (see column 3 lines 1-6 and column 4 lines 20-40).

Benjamin does not disclose expressly printing a document including at least the identification code of the replaceable component.

Best discloses replaceable components having identification numbers that are stored in an allocation table which can be displayed when needed (see column 7 lines 30-32 and column 8 lines 10-21).

Regarding claim 3, Benjamin discloses sending an electronic mail message including a contact for ordering a replacement replaceable component to a computer (see column 4 lines 20-50, reference discloses the ability to automatically be connected to a website to order a replacement cartridge or be sent a electronic message over the internet which would contain a contact for ordering a replacement component).

Benjamin does not disclose expressly sending an electronic mail message including the identification code of the replaceable component.

Best discloses replaceable components having identification numbers (see column 8 lines 10-21).

Regarding claim 4, Benjamin discloses printing a document including information for at least one of returning, using, and installing the replaceable component (see column 4 lines 20-50).

Regarding claim 7, Benjamin discloses printing a document including information for the replaceable component identifying at least one of: (a) manufacturer, (b) vendor; (c) third party; (d) equivalent apparatus and respective identification code; (e) phone number; and (f) facsimile number (see column 4 lines 20-50).

Regarding claim 8, Benjamin discloses wherein the replaceable component is at least one of a toner cartridge, developer cartridge, print cartridge, ink cartridge, printhead, and photoreceptor drum (see column 3 lines 1-6 and column 4 lines 20-40).

Regarding claim 9, Benjamin discloses wherein the memory storage device further comprises a contact for ordering a replacement toner cartridge and printing a



document including a contact for ordering a replacement toner cartridge (see column 4 lines 20-50).

Benjamin does not disclose expressly wherein the replaceable component is a toner cartridge and printing a document including at least the identification code of the toner cartridge.

Best discloses wherein the replaceable component is a toner cartridge (see column 4 lines 45-55) and replaceable components having identification numbers (see column 8 lines 10-21).

Benjamin & Best are combinable because they are from the same field of endeavor, replaceable components in printing systems.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the identification aspect of Best with the print system of Benjamin to obtain a replaceable component that carries as part of its data an identification code that can be sent to the printer and then output.

The suggestion/motivation for doing so would have been to be able to identify each replaceable component by use of a unique identification code to enable easier ordering and the ability to obtain maintenance records of a particular component (see column 10 lines 17-27 of Best).

Therefore, it would have been obvious to combine Best with Benjamin to obtain the invention as specified in claims 1-4 and 7-9.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin as applied to claim 13 above, and further in view of Best.

Benjamin does not disclose expressly printing an identification code for the replaceable unit.

Best discloses replaceable components having associated identification numbers located in an allocation table which can be displayed as needed (see column 7 lines 30-32 and column 8 lines 10-21).

Benjamin & Best are combinable because they are from the same field of endeavor, replaceable components in printing systems.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the identification aspect of Best with the print system of Benjamin to obtain a replaceable component that carries as part of its data an identification code that can be sent to the printer and then output.

The suggestion/motivation for doing so would have been to be able to identify each replaceable component by use of a unique identification code to enable easier ordering and the ability to obtain maintenance records of a particular component (see column 10 lines 17-27 of Best).

Therefore, it would have been obvious to combine Best with Benjamin to obtain the invention as specified in claims 17.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin as applied to claim 13 above, and further in view of U.S. Patent Application Publication No. 2001/0003827 to Shimamura.

Benjamin does not disclose expressly printing a log of previously printed documents about the replaceable unit.

Shimamura discloses printing a log of printer related error or printer attributes (see paragraph numbers [0036], [0080], [0096]-[0099], [0101]-[0102], and Fig. 5).

Benjamin & Shimamura are combinable because they are from the same field of endeavor, monitoring the printing process.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the print log of Shimamura with the system of Benjamin.

The suggestion/motivation for doing so would have been to provide maintenance information that can decrease down time and increase productivity by using previous data to predict future occurrences (see [0099]-[0100] of Shimamura).

Therefore, it would have been obvious to combine Shimamura with Benjamin to obtain the invention as specified in claim 16.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 14-18, and 19-20 of U.S. Patent

No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to have a method for providing information to a user based on the apparatus set forth in the above stated patent. Also, the patented apparatus is capable of performing all the steps recited in the method claims of the application. For further clarity claims 1-9 relate to patented claims 7, 8, 21, 17, 14, 15, 16, 18, and 20 respectively.

Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because a printing method and printing system are analogous. It would have been obvious to provide a method based on the print system claimed in the above stated patent. Also, the patented system is capable of performing all the steps recited in the method claim of the application.

Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because a printing method and printing system are analogous. It would have been obvious to provide a method based on the print system claimed in the above stated patent. Also, the patented system is capable of performing all the steps recited in the method claim of the application.

Claims 13 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent

No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because a printing method and printing system are analogous. It would have been obvious to provide a method based on the print system claimed in the above stated patent. Also, the patented system is capable of performing all the steps recited in the method claim of the application.

Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 8 of U.S. Patent No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to have a printing method based on the apparatus set forth in the above stated patent. Also, the patented apparatus is capable of performing all the steps recited in the method claims of the application.

Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6584290 to Kurz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because a printing method and printing system are analogous. It would have been obvious to provide a method based on the print system claimed in the above stated patent. Also, the patented system is capable of performing all the steps recited in the method claim of the application. Claim 3 states printing a document that comprises information for recycling which could be a return address or return label and therefore claim 19 of the application is analogous.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (703) 305-1900. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (703) 305-4712. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia  
Examiner  
Art Unit 2622

MRM

JOSEPH R. POKRZYWA  
EXAMINER  
ART UNIT 2622

*Joseph R. Pokrzywa*

*Ed Coles*  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600